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Jennifer D. Gaines
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PATENT

Atty. Docket No. 31045-19

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Anthony Cox, et al.

Serial No.: 10/630,032

Filed: July 30, 2003

For: Shoe Bottom Having Interspersed
Materials

Group Art Unit: 3728

Examiner: Kavanaugh, John T.

Conf. No.: 7770

RESPONSE TO RESTRICTION REQUIREMENT

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This submission is made in response to the Office Action dated January 26, 2005, a
Petition for Revival and requisite fee being filed concurrently herewith.

In response to the restriction requirement set forth in the Office Action, Applicants provisionally elect the Group II claims (claims 16-32) for prosecution.

In addition, the Office Action includes an election requirement. Specifically, the Office Action asserts that the application contains certain identified species of “the claimed invention”. It is not entirely clear to which identified “invention” this statement is referring. However, it seems most reasonable that the referenced “invention” refers to the Group I claims, in view of the fact that the only descriptions of the purported species are illustrations of apparatuses. Because the Group II claims have been elected above, no election is believed necessary.

In any event, if an election is required then further clarification is respectfully requested, because the Office Action does not appear to adequately identify the purported species in a manner that would permit Applicants to make a meaningful election. That is, Applicants are unable to discern exactly what are the “distinct inventions”, as that term is used in the cited code section 35 USC § 121, that correspond to the purported species.

Moreover, the Office Action has not provided any grounds for requiring an election, other than making an unsupported assertion that the claims are directed to patentably distinct species. For example, the Office Action has made no showing that any identified species “are independent or distinct”, as required under MPEP §§ 806.04, 806.04(b), 808 and 808.01(a). In this regard, MPEP § 808 provides, “Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required...” The present Office Action has not shown either of these elements.

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Finally, it is noted that 37 CFR § 1.146 provides, "if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application." Here, however, the Office Action has not asserted that there are more than a reasonable number of species.

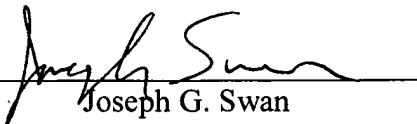
As noted above, it is not believed that the species election requirement applies to the Group II claims. Accordingly, no election has been made. If an election is required, Applicants respectfully request that the examiner provide a clear description of the purported species, together with a clear statement of the reasons for requiring the election and the reasons why there would be a serious burden on the examiner if restriction is not required.

If there are any additional fees due in connection with the filing of this paper that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 13-3735. If an extension of time under 37 C.F.R. 1.136 is required for the filing of this paper and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account. A duplicate copy of this page is enclosed for that purpose.

Dated: March 21, 2006

Respectfully submitted,
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